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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: DeLima et al.

Serial No. 09/904,025

Filed: July 12, 2001

For: Method and Apparatus for Policy-
Based Packet Classification§
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Group Art Unit: 2143

Examiner: Jean Gilles, Jude

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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By:

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APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on March 28, 2006.

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0461. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

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REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-38

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1 - 38
4. Claims allowed: None
5. Claims rejected: 1-4, 7, 8, 12-18, 21, 22, 26-30, 33, 34, and 38
6. Claims objected to: 5, 6, 9-11, 19, 20, 23-25, 31, 32, and 35-37

C. CLAIMS ON APPEAL

The claims on appeal are: 1-4, 7, 8, 12-18, 21, 22, 26-30, 33, 34, and 38

STATUS OF AMENDMENTS

A Response to Final Office Action was filed on March 6, 2006. The Final Office Action states that claims 5, 6, 9-11, 19, 20, 23-25, 31, 32, and 35-37 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Appellant rewrote the claims in independent form to overcome this objection. However, in an Advisory Action, the Examiner stated that the amendments to the claims would not be entered because the amendments to the claims, as required by the Examiner in the Final Office Action, "raised new issues which require new search and further consideration." The claims on Appeal herein are as finally rejected in the Final Office Action dated December 28, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER**A1. CLAIM 1 - INDEPENDENT**

Claim 1 is directed to a method in a data processing system processing a request. A request is received (Specification pg. 17, lines 18-19; Figure 6, step 600). In response to a first hash value being present within the request, the first hash value is compared to a second hash value (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for a quality of service (Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6, step 606). In response to a match between the first hash value and the second hash value, a quality of service is set based on information associated with the first hash value (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

A1. CLAIM 13 - INDEPENDENT

Claim 13 is directed to a data processing system comprising a bus system, a communications unit connected to the bus system (Specification pg. 12, lines 13-28, Figure 2, modem 218); a memory unit connected to the bus system (Specification pg. 12, lines 3-6, Figure 2, processors 202, 204) and a processing unit connected to the bus unit (Specification pg. 12, lines 7-9, Figure 2, memory controller/cache 208). The memory contains instructions and the processing unit executes the instructions. The processing unit executes a set of instructions to receive a request (Specification pg. 17, lines 18-19; Figure 6, step 600). Then, in response to a first hash value being present within the request, the processing unit executes a set of instructions to compare the first hash value to a second hash value (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for a quality of service (Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6, step 606). Then, in response to a match between the first hash value and the second hash value, the processing unit executes a set of instructions to set a quality of service based on information associated with

the first hash value (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

A1. CLAIM 15 - INDEPENDENT

Claim 15 is directed to a data processing system for processing a request. The data processing system has a receiving means (Specification pg 13, line 19 -21, Figure 3, policy agent 306) for receiving the request (Specification pg. 17, lines 18-19; Figure 6, step 600). In response to a first hash value being present within the request, a comparing means (Specification pg 13, line 19 -21; pg. 15, lines 1-9; Figure 3, policy agent 306) compares the first hash value to a second hash value (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for a quality of service (Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6, step 606). In response to a match between the first hash value and the second hash value, a setting means (Specification pg 15, line 10 – pg. 16, line 5; Figure 3, TCP/IP stack 308) sets a quality of service based on information associated with the first hash value (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

A1. CLAIM 27 - INDEPENDENT

Claim 27 is directed to a computer program product for processing a request. A request is received (Specification pg. 17, lines 18-19; Figure 6, step 600). In response to a first hash value being present within the request, the first hash value is compared to a second hash value (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for a quality of service (Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6, step 606). In response to a match between the first hash value and the second hash value, a quality of service is set based on information associated with the first hash value (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

A2. CLAIM 8 – INDEPENDENT

Claim 8 is directed to a method in a data processing system for processing a request. In response to receiving a request containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value (Specification pg. 10, line 6 – pg. 11, line 3; pg. 13, lines 23-28; pg. 17, lines 18-19; Figure 6, step 600), determining whether the first hash value corresponds to a second hash value. (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for processing requests by the data processing system (Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6, step 606). In response to a correspondence between the first hash value and the second hash value, processing the request using the information (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

A2. CLAIM 14 – INDEPENDENT

Claim 14 is directed to a data processing system comprising a bus system, a communications unit connected to the bus system (Specification pg. 12, lines 13-28, Figure 2, modem 218); a memory unit connected to the bus system (Specification pg. 12, lines 3-6, Figure 2, processors 202, 204) and a processing unit connected to the bus unit (Specification pg. 12, lines 7-9, Figure 2, memory controller/cache 208). The memory contains instructions and the processing unit executes the instructions. The processing unit executes a set of instructions to receive a request (Specification pg. 17, lines 18-19; Figure 6, step 600). Then, in response to receiving a request containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value (Specification pg. 10, line 6 – pg. 11, line 3; pg. 13, lines 23-28; pg. 17, lines 18-19; Figure 6, step 600), determining whether the first hash value corresponds to a second hash value. (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for processing requests by the data processing system (Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6,

step 606). In response to a correspondence between the first hash value and the second hash value, processing the request using the information (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

A2. CLAIM 22 - INDEPENDENT

Claim 22 is directed to a data processing system for processing a request. In response to receiving a request (Specification pg. 17, lines 18-19; Figure 6, step 600) containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value (Specification pg. 10, line 6 – pg. 11, line 3; pg. 13, lines 23-28; pg. 17, lines 18-19; Figure 6, step 600), a determining means (Specification pg. 13, line 19 -21; pg. 15, lines 1-9; Figure 3, policy agent 306) determines if the first hash value corresponds to a second hash value (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for processing requests by the data processing system (Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6, step 606). In response to a correspondence between the first hash value and the second hash value, a processing means (Specification pg. 15, line 10 – pg. 16, line 5; Figure 3, TCP/IP stack 308) processes the request using the information (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

A2. CLAIM 34 - INDEPENDENT

Claim 34 is directed to a computer program product for processing a request. Responsive to receiving a request (Specification pg. 17, lines 18-19; Figure 6, step 600) containing a selected cookie in which the selected cookie includes a first hash value and information associated with the first hash value (Specification pg. 10, line 6 – pg. 11, line 3; pg. 13, lines 23-28; pg. 17, lines 18-19; Figure 6, step 600), instructions are executed to determine if the first hash value corresponds to a second hash value (Specification pg. 15, lines 1-9; pg. 17, lines 22-24; pg. 18, lines 9-18; pg. 21, lines 6-9; Figure 6, step 602 and 608). The second hash value represents a current policy configuration for processing requests by the data processing system

(Specification pg. 14, lines 1-6; pg. 15, lines 1-9; pg. 18, lines 7-9; pg. 21, lines 6-9; Figure 6, step 606). In response to a correspondence between the first hash value and the second hash value, instructions are executed to process the request using the information (Specification pg. 15, lines 1-9; pg. 18, lines 18-22; pg. 21, lines 9-12; Figure 6, step 610).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL**A. GROUND OF REJECTION 1 (Claims 1, 7, 8, 12-15, 21, 22, 26, 27, 33, 34, and 38)**

Whether claims 1, 7, 8, 12-15, 21, 22, 26, 27, 33, 34, and 38 are obvious under 35 U.S.C. § 103 over Edelman, U. S. Patent No. 6,857,067 B2 in view of Mohaban et al., U.S. Patent No. 6,788,647 B1.

B. GROUND OF REJECTION 2 (Claims 2-4, 16-18, and 28-30)

Whether claims 2-4, 16-18, and 28-30 are obvious under 35 U.S.C. § 103 over Edelman, U. S. Patent No. 6,857,067 B2 in view of Mohaban et al., U.S. Patent No. 6,788,647 B1, and further in view of Masters, U.S. Patent No. 6,374,300 B2.

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1, 7, 8, 12-15, 21, 22, 26, 27, 33, 34, and 38)

The Final Office Action rejects claims 1, 7, 8, 12-15, 21, 22, 26, 27, 33, 34, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Edelman, U. S. Patent No. 6,857,067 B2 in view of Mohaban et al., U.S. Patent No. 6,788,647 B1.

A1. 35 U.S.C. § 103, Obviousness, claims 1, 7, 13, 15, 21, 27, and 33

Regarding Claims 1 and 15, the Final Office Action states:

Regarding claims 1 and 15, Edelman teaches the invention substantially as claimed. Edelman discloses a method in a data processing system for processing a request, the method comprising:

receiving the request (column 3, lines 42-45; column 4, lines 43-55);

responsive to a first hash value being present within the request,

comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration (column 10, lines 13-63).

However, Edelman does not specifically teach the current policy configuration to be a for a quality of service and that responsive to a match between the first hash value and the second hash value, setting a quality of service based on information associated with the first hash value.

In the same field of endeavor, Mohaban discloses a method for "creating and storing an entry in a table that uniquely identifies the network data flow and that includes the inbound value" [See Mohaban; column 6, line 51-55; column 8, lines 40-67; column 9, lines 1-3].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Mohaban's teachings of a method and apparatus to use hash value to set the quality of service, with the teachings of Edelman, for the purpose of "*preventing unauthorized access to electronic data stored on an electronic device*" as stated by Edelman in lines 1-4 of column 5. Thus, Mohaban also provides motivation to combine by stating a need to also provide to the network with "*a way to set quality of service values for packets transmitted in the network flow in both directions of a flow among a sender and a receiver.*" [See Mohaban column 5, lines 5-8]. By this rationale claims 1 and 15 are rejected.

Final Office Action dated December 28, 2005, pages 3 and 4.

A fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Additionally, in comparing Edelman to the claimed invention, the claim limitations of the presently claimed invention may not be ignored in an obviousness determination.

Independent claim 1, which is representative of independent claims 13, 15, and 27 with regard to similarly recited subject matter, recites:

1. A method in a data processing system for processing a request, the method comprising:
 - receiving the request;
 - responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service; and
 - responsive to a match between the first hash value and the second hash value, setting a quality of service based on information associated with the first hash value.

Edelman does not teach or suggest all the claim limitations in independent claim 1. Specifically, Edelman does not teach the feature of "responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service." Such a feature is not taught or suggested by Edelman. Therefore, claim 1 is not obvious in view of Edelman because the features believed to be disclosed by this cited reference are not present.

The Final Office Action points to column 10, lines 13 through 63 of Edelman, reproduced below for the Board's convenience, as teaching the feature of "responsive to a first hash value

being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service:"

The private key used by the software protection administrator may be one of a set of private keys, e.g., a set of 100 keys. Using a large set of private keys makes cracking any particular key in the set more difficult, since a different key may be used for each update.

The client program receives the new data and encrypted hash and stores it on the smart card. Each time the smart card is accessed in this manner, the smart card performs a hash comparison using its internal processor to prevent unauthorized changes to the smart card data.

To perform the hash comparison, the smart card processor decrypts the hash received from the registration authority using a public key. The smart card then generates a hash for the new data. The generated hash and the decrypted hash are compared to ensure that the new data came from the registration authority.

The new smart card data sent by the registration authority also includes a new smart card sequence number, a new expiration date for the smart card, software license expiration dates, and software security expiration dates.

The smart card sequence number allows the registration authority to track updates to the smart card. For example, the sequence number may be an n-bit (where n is an integer) word that is incremented each time the smart card is updated. This feature allows the registration authority to detect unauthorized access to the smart card.

The software license expiration date is determined by a configurable time period during which the license is valid based on the license agreement with the user. For example, the software license expiration period may be one hour, one day, thirty days, one year, or any agreed upon period of time.

Each software license may have a corresponding software security expiration date that is determined by a configurable time period within which the user must reconnect to the registration authority to renew the software license. The software security expiration period may be determined by the vendor based on security considerations and may be any desired length of time.

The smart card expiration date is determined by configurable time period during which the smart card will operate. The smart card expiration period may be determined by the software protection administrator based on security or other considerations and may be any desired length of time, e.g., 30 days. The smart card expiration period may be set to be equal to the shortest software security expiration period stored on the card.

The smart card must be updated by the registration authority within the smart card expiration and software security expiration periods for the user to have uninterrupted use of the software. Consequently, if a smart card were lost or stolen, an unauthorized user would only be able to use the smart card for the remainder of the shortest of these expiration periods. In addition, the lost or stolen

smart card can be disabled the next time the electronic device communicates with the registration authority.

The above cited passage of Edelman teaches decrypting a hash provided from a third party and then generating a hash for new data received and comparing the two hashes. Matching the two hashes verifies that the data came from the same source as the encrypted hash and that the data is therefore valid.

While the above cited passage does teach comparing two hashes, neither these hashes nor any other portion of Edelman, is directed towards policies. The MPEP §2173.05(a) states "When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art." *In re Zeltz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). The specification, on page 9, lines 26 through 28, defines the term "policy" as "a set of rules, also referred to as policy rules, used to handle packets."

The Edelman reference is not concerned with packets or policies for handling packets. Instead, the Edelman reference is concerned with verifying the validity of the identity of a source of data. As Edelman does not teach packets or policies for handling packets, the above cited passage of Edelman cannot teach a second hash value that represents a current policy configuration for a quality of service. Thus, Edelman does not teach the feature of "responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service."

Furthermore, Mohaban does not cure the deficiencies of Edelman. Mohaban does not teach the feature missing from Edelman, "responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service," nor does the Examiner point to any portion of Mohaban that teaches this feature. Mohaban does not teach hash values representing a quality of service. Rather, Mohaban teaches generating a hash and storing the hash in a table, wherein the hash presents either information identifying a data flow or a combination of information identifying a data

flow and a quality of service (See Mohaban col. 7, lines 3 -6; col. 8, line 61 – col. 9, line 3). Furthermore, Mohaban does not teach receiving a request that has a hash value present within the request. Instead, Mohaban teaches “obtaining information that identifies the current flow in the message elements and looking it up in the hash table.” (Mohaban, col. 9, lines 11-13).

Therefore, as neither Edelman nor Mohaban nor the combination of Edelman in view of Mohaban teaches responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration, it follows that neither Edelman nor Mohaban nor the combination of Edelman in light of Mohaban teaches the feature of “responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service,” as recited in claim 1 of the present invention. Accordingly, the Final Office Action fails to state a case of *prima facie* obviousness.

Additionally, stating that it is obvious to try or make a modification or combination without a suggestion in the prior art is not *prima facie* obviousness. The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). An Office Action may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

Obviousness under section 103 is directed to compositions and methods, and not to making efforts and attempts. Slight reflection suggests that there is an element of “obvious to try” in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success, and patentability determinations based on that as a test would result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of research. Therefore, a modification or

combination is obvious only if it is obvious to do from some teaching or suggestion in the prior art with a reasonable expectation of success.

A Final Office Action does not provide any valid motivation to combine the cited references. The alleged motivations provided by the Office Action are a restatement of the problem that each reference is trying to solve, without making any connection between the two problems or stating how the problems are in any way related. Neither of the references teaches anything about the problem or source of the other reference. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. at 687. Thus, when Edelman is examined as a whole, Edelman teaches one of ordinary skill in the art a method for validating the source of received data and for preventing unauthorized access to electronic data stored on an electronic device. Mohaban is directed towards a method for "automatic reverse-direction or bi-directional quality of service treatment of network data flows." (see Mohaban, Abstract). As neither reference teaches anything about the problem or source of the other reference, one of ordinary skill in the art would not be motivated to make the changes proposed by the Final Office Action.

Furthermore, no motivation exists to combine the cited references. The present invention recognizes the need for an improved method of classifying packets in order to decrease the time needed to route a package to its destination. Edelman does not teach the problem or its source. Instead, Edelman is directed to validating the source of received data and preventing unauthorized access to electronic data stored on an electronic device. Neither does Mohaban teach the problem or its source. Instead, Mohaban is directed towards "automatic reverse-direction or bi-directional quality of service treatment of network data flows." (see Mohaban, Abstract). The process Edelman describes occurs in the application layer, whereas the problem and solution taught by Mohaban occur in the transport layer. Neither of the cited references teaches the problem or source of the problem solved by the present invention. Therefore, one of ordinary skill in the art would not be motivated to combine or modify the references in the manner required to form the solution disclosed in the claimed invention. Accordingly, it is not possible to state a *prima facie* case of obviousness.

The presently claimed invention may be reached only through an improper use of the disclosed invention as a template to modify the prior art to reach the claimed invention. An Examiner may not make modifications to the prior art using the claimed invention as a model for the modifications. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art has suggested the desirability of the modification." *Id.* In other words, unless some teaching exists in the prior art for the suggested modification, merely asserting that such a modification would be obvious to one of ordinary skill in the art is improper and cannot be used to meet the burden of establishing a *prima facie* case of obviousness. Such reliance is an impermissible use of hindsight with the benefit of Appellants' disclosure.

Therefore, absent some teaching, suggestion, or incentive in the prior art, Edelman and Mohaban cannot be properly modified to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed modifications, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Appellants' invention as a model.

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Furthermore, even if Edelman and Mohaban could be properly combined, a combination of Edelman and Mohaban would not form the presently claimed invention as recited in claim 1. Instead, a combination of Edelman and Mohaban would, at best, result in a method for validating the source of received data and preventing unauthorized access to electronic data stored on an electronic device, which can also provide automatic reverse-direction or bi-directional quality of service treatment of network data flows.

Additionally, Mohaban teaches examining each inbound data packet, determining a quality of service and a flow for the data packet. The quality of service value is stored along with information identifying the network data flow in a hash table. However, the hash itself is a hash of the information that identifies the flow, not a hash that represents the quality of service, as recited in claim 1. When an outbound data packet is detected, Mohaban teaches hashing the

information in the outbound data packet that identifies what flow the outbound packet belongs to and comparing that hash value to the hash values in the table and if a match is found, applying the quality of service associated with the hash value that is also stored in the hash table.

Therefore, the combination of Edelman and Mohaban would not reach the presently claimed invention. Accordingly, the Final Office Action fails to state a case of *prima facie* obviousness.

Thus, for all the reasons set forth above, Appellants submit that independent claims 1, 13, 15, and 27 are patentable over the cited references as neither Edelman, Mohaban nor a combination of Edelman in view of Mohaban teaches the present invention as recited in claims 1, 13, 15, and 27.

Claims 7, 21, and 33 are dependent claims depending from independent claims 1, 15, and 27. As Applicants have already demonstrated that independent claims 1, 15, and 27 are patentable over Edelman and Mohaban references, Applicants submit that dependent claims 7, 21, and 33 are patentable over the Edelman and Mohaban references at least by virtue of depending from an allowable claim.

Therefore, Appellants respectfully request that the rejection of claims 1, 7, 13, 15, 21, 27, and under 35 U.S.C. § 103 be reversed.

A2. 35 U.S.C. § 103, Obviousness, claims 8, 12, 14, 22, 26, 34, and 38

Regarding Claim 8, the Final Office Action states:

Regarding claim 8, the combination Edelman-Mohaban teaches a method in a data processing system for processing a request, the method comprising:
responsive to receiving a request containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value, determining whether the first hash value corresponds to a second hash value, wherein the second hash value represents a current policy configuration for processing requests by the data processing system [see Edelman; column 10, lines 13-63]; [see Mohaban; column 6, line s1-15; column 8, lines 40-67; column 9, lines 1-3]; and

responsive to a correspondence between the first hash value and the second hash value, processing the request using the information [see Edelman; column 10, lines 13-63]; [see Mohaban; column 6, line s1-15; column 8, lines 40-67; column 9, lines 1-3]. The same motivation that was used for the rejection of

claim 1 is also valid for claim 8 [see Mohaban; column 5, lines 5-8]. By this rationale, claim 8 is rejected.

Final Office Action dated December 28, 2005, pages 4 and 5.

Independent claim 8, which is representative of independent claims 14, 22, and 34 with regard to similarly recited subject matter, recites:

8. A method in a data processing system for processing a request, the method comprising:

responsive to receiving a request containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value, determining whether the first hash value corresponds to a second hash value, wherein the second hash value represents a current policy configuration for processing requests by the data processing system; and

responsive to a correspondence between the first hash value and the second hash value, processing the request using the information.

As was discussed above in regards to the rejection of claim 1, neither Edelman, Mohaban, nor the combination of Edelman in view of Mohaban, teaches the feature of "responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service."

Additionally, neither Edelman, nor Mohaban, nor the combination of Edelman in view of Mohaban, teaches receiving a request containing a selected cookie, wherein the selected cookie contains the first hash value and information associated with the first hash value, nor does the Final Office Action cite to any section of Edelman or Mohaban as teaching this feature. Additionally, on page 9, the Final Office Action states "Edelman-Mohaban discloses the data processing system of claim 1, but fails to disclose a method wherein the first hash value and the information are located in a cookie within the request."

Therefore, as neither Edelman nor Mohaban nor the combination of Edelman in view of Mohaban teaches receiving a request containing a selected cookie, wherein the selected cookie contains the first hash value and information associated with the first hash value, it follows that neither Edelman nor Mohaban nor the combination of Edelman in light of Mohaban teaches the feature of "responsive to receiving a request containing a selected cookie in which the selected

cookie includes a first hash value and information associated with the hash value, determining whether the first hash value corresponds to a second hash value, wherein the second hash value represents a current policy configuration for processing requests by the data processing system," as recited in claim 8 of the present invention. Accordingly, the Final Office Action fails to state a case of *prima facie* obviousness.

Additionally, as was discussed above in regards to the rejection of claim 1, the Final Office Action fails to provide a valid motivation to combine the cited references. Furthermore, as discussed above in regards to the rejection of claim 1, the present invention can be reached only through an improper use of hindsight with Appellants' invention as a model. Also, as was discussed above in regards to the rejection of claim 1, even if the cited references could be properly combined, the references would still not teach the invention as recited in claim 8.

Therefore, for all the reasons set forth above, Appellants submit that independent claims 8, 14, 22, and 34 are patentable over the cited references as neither Edelman, Mohaban, nor a combination of Edelman in view of Mohaban, teach the present invention as recited in claims 8, 14, 22, and 34.

Claims 12, 26, and 38 are dependent claims depending from independent claims 8, 22, and 34. As Applicants have already demonstrated that independent claims 8, 22, and 34 are patentable over the Edelman and Mohaban references, Applicants submit that dependent claims 12, 26, and 38 are patentable over the Edelman and Mohaban references at least by virtue of depending from an allowable claim.

Therefore, Appellants respectfully request that the rejection of claims 8, 12, 22, 26, 34 and 38 under 35 U.S.C. § 103 be reversed.

B. GROUND OF REJECTION 2 (Claims 2-4, 16-18, and 28-30)

The Final Office Action rejects claims 2-4, 16-18, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Edelman, U. S. Patent No. 6,857,067 B2 in view of Mohaban et al., U.S. Patent No. 6,788,647 B1, and further in view of Masters, U.S. Patent No. 6,374,300 B2.

With regards to claim 2, the Office Action states:

Claims 2-4, 16-18, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelman and Mohaban, as applied to claims 1, 8, 15, 22,

27 and 34 above, and in further view of Masters (Masters), U.S. Patent No. 6,374,300 B2.

Regarding claim 2, the combination Edelman-Mohaban teaches the invention substantially as claimed. Edelman-Mohaban discloses the data processing system of claim 1, but fails to disclose a method wherein the first hash value and the information are located in a cookie within the request.

Final Office Action dated December 28, 2005, page 9.

Claim 2, which is representative of claims 16 and 28 with regard to similarly recited subject matter, depends from independent claim 1. As was discussed above with regards to the rejection of claim 1, neither Edelman, Mohaban, nor the combination of Edelman in view of Mohaban, teaches the feature of "responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service." Masters does not cure this deficiency. Masters does not teach the feature of "responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service," nor does the Final Office Action cite any portion of Masters as teaching the feature. Masters teaches inserting a hash into a cookie in order to identify a relationship between the client and the destination.

Additionally, stating that it is obvious to try or make a modification or combination without a suggestion in the prior art is not *prima facie* obviousness. The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). A Final Office Action may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

Obviousness under section 103 is directed to **compositions** and **methods**, and not to making **efforts** and **attempts**. Slight reflection suggests that there is an element of "obvious to

try" in any research endeavor; that it is not undertaken with complete blindness but rather with some semblance of a chance of success, and patentability determinations based on that as a test would result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name research. Therefore, a modification or combination is obvious only if it is obvious to do from some teaching or suggestion in the prior art with a reasonable expectation of success.

The Final Office Action does not provide any valid motivation to combine the cited references. The alleged motivations provided by the Final Office Action are a restatement of the problem that each reference is trying to solve, without making any connection between the problems of the references or without stating how the problems are in any way related. None of the references teaches anything about the problem or source of the other references. "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. at 687. Thus, when Edelman is examined as a whole, Edelman teaches one of ordinary skill in the art a method for validating the source of received data and for preventing unauthorized access to electronic data stored on an electronic device. Mohaban is directed towards a method for "automatic reverse-direction or bi-directional quality of service treatment of network data flows." (see Mohaban, Abstract). Masters teaches inserting a hash into a cookie in order to identify a relationship between the client and the destination. As none of the references teaches anything about the problem or source of the other references, one of ordinary skill in the art would not be motivated to make the changes proposed by the Final Office Action.

Furthermore, no motivation exists to combine the cited references. The present invention recognizes the need for an improved method of classifying packets in order to decrease the time needed to route a package to its destination. Edelman does not teach the problem or its source. Instead, Edelman is directed to validating the source of received data and preventing unauthorized access to electronic data stored on an electronic device. Neither does Mohaban teach the problem or its source. Instead, Mohaban is directed towards "automatic reverse-direction or bi-directional quality of service treatment of network data flows." (see Mohaban,

Abstract). Masters does not teach the problem or its source either. Masters teaches inserting a hash into a cookie in order to identify a relationship between the client and the destination. None of the cited references teaches the problem or source of the problem solved by the present invention. Therefore, one of ordinary skill in the art would not be motivated to combine or modify the references in the manner required to form the solution disclosed in the claimed invention. Accordingly, it is not possible to state a *prima facie* case of obviousness.

The presently claimed invention may be reached only through an improper use of the disclosed invention as a template to modify the prior art to reach the claimed invention. An Examiner may not make modifications to the prior art using the claimed invention as a model for the modifications. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art has suggested the desirability of the modification." *Id.* In other words, unless some teaching exists in the prior art for the suggested modification, merely asserting that such a modification would be obvious to one of ordinary skill in the art is improper and cannot be used to meet the burden of establishing a *prima facie* case of obviousness. Such reliance is an impermissible use of hindsight with the benefit of Appellants' disclosure.

Therefore, absent some teaching, suggestion, or incentive in the prior art, Edelman, Mohaban, and Masters cannot be properly modified to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed modifications, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Appellants' invention as a model.

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Furthermore, even if Edelman, Mohaban, and Masters could be properly combined, a combination of Edelman, Mohaban, and Masters would not form the presently claimed invention as recited in claim 2. Instead, a combination of Edelman, Mohaban, and Masters would, at best, result in a method for using cookies to validate the source of received data and prevent

unauthorized access to electronic data stored on an electronic device, which can also provide automatic reverse-direction or bi-directional quality of service treatment of network data flows.

Additionally, Mohaban teaches examining each inbound data packet, determining a quality of service and a flow for the data packet. The quality of service value is stored along with information identifying the network data flow in a hash table. However, the hash itself is a hash of the information that identifies the flow, not a hash that represents the quality of service, as recited in claim 1. When an outbound data packet is detected, Mohaban teaches hashing the information in the outbound data packet that identifies what flow the outbound packet belongs to and comparing that hash value to the hash values in the table and if a match is found, applying the quality of service associated with the hash value that is also stored in the hash table.

Therefore, the combination of Edelman, Mohaban and Masters would not reach the presently claimed invention. Accordingly, the Final Office Action fails to state a case of *prima facie* obviousness.

Claims 2-4, 16-18, and 28-30 are dependent claims depending from independent claims 1, 15, and 27. As Applicants have already demonstrated that independent claims 1, 15, and 27 are patentable over the combination of Edelman in view of Mohaban and Edelman in view of Mohaban further in view of Masters, Applicants submit that dependent claims 2-4, 16-18, and 28-30 are patentable over the Edelman in view of Mohaban further in view of Masters references, at least by virtue of depending from an allowable claim.

Therefore, Appellants respectfully request that the final rejection of claims 2-4, 16-18, and 28-30 under 35 U.S.C. § 103 be reversed.



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CLAIMS APPENDIX

The text of the claims involved in the appeal are:

1. A method in a data processing system for processing a request, the method comprising:
receiving the request;
responsive to a first hash value being present within the request, comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service; and
responsive to a match between the first hash value and the second hash value, setting a quality of service based on information associated with the first hash value.
2. The method of claim 1, wherein the first hash value and the information are located in a cookie within the request.
3. The method of claim 2, wherein the cookie is located within a header of the request.
4. The method of claim 1, wherein the request is a hypertext transport protocol request.
5. The method of claim 1 further comprising:
responsive to an absence of a hash value in the request, identifying a policy rule for processing the request to form an identified policy rule;
identifying a classification for the request using the identified policy rule;

hashing the current policy configuration, of which the identified policy rule is a part,
using a hashing algorithm to generate a current hash value; and
placing the current hash value and the information into the request.

6. The method of claim 5, wherein the hash value and the information are placed into a cookie.

7. The method of claim 1, wherein the data processing system is a server.

8. A method in a data processing system for processing a request, the method comprising:
responsive to receiving a request containing a selected cookie in which the selected
cookie includes a first hash value and information associated with the hash value, determining
whether the first hash value corresponds to a second hash value, wherein the second hash value
represents a current policy configuration for processing requests by the data processing system;
and

responsive to a correspondence between the first hash value and the second hash value,
processing the request using the information.

9. The method of claim 8 further comprising:

responsive to receiving a request containing the selected cookie, determining whether the
selected cookie is stale;

responsive to an absence of a determination that the cookie being is stale, generating a new classification for the request for the request; and

responsive to the cookie being stale, preventing initiation of the determining step.

10. The method of claim 9 further comprising:

responsive to an absence of the selected cookie, processing the request with the current policy configuration to generate a first classification for the request;

applying a hashing algorithm to the current policy configuration to generate the first hash value; and

placing the first hash value and information associated with the first hash value within a new cookie.

11. The method of claim 8, wherein the selected cookie includes a universal resource identifier, a user identification, and a user group identification.

12. The method of claim 8, wherein the information includes a quality of service indicator.

13. A data processing system comprising:

a bus system;

a communications unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to receive the request; compare the first hash value to a second hash value in response to a first hash value being present within the request, wherein the second hash value represents a current policy configuration for a quality of service; and set a quality of service based on information associated with the first hash value in response to a match between the first hash value and the second hash value.

14. A data processing system comprising:

a bus system;

a communications unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instructions to determine whether the first hash value corresponds to a second hash value in response to receiving a request containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value, wherein the second hash value represents a current policy configuration for processing requests by the data processing system; and process the request using the information in response to a correspondence between the first hash value and the second hash value.

15. A data processing system for processing a request, the comprising:

receiving means for receiving the request;

comparing means, responsive to a first hash value being present within the request, for comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service; and

setting means, responsive to a match between the first hash value and the second hash value, for setting a quality of service based on information associated with the first hash value;

16. The data processing system of claim 15, wherein the first hash value and the information are located in a cookie within the request.

17. The data processing system of claim 16, wherein the cookie is located within a header of the request.

18. The data processing system of claim 15, wherein the request is a hypertext transport protocol request.

19. The data processing system of claim 15 further comprising:

first identifying means, responsive to an absence of a hash value in the request, for identifying a policy rule for processing the request to form an identified policy rule;

second identifying means for identifying a classification for the request using the identified policy rule;

hashing means for hashing the current policy configuration, of which the identified policy rule is a part, using a hashing algorithm to generate a current hash value; and

placing means for placing the current hash value and the information into the request.

20. The data processing system of claim 19, wherein the hash value and the information are placed into a cookie.

21. The data processing system of claim 15, wherein the data processing system is a server.

22. A data processing system for processing a request, the data processing system comprising:

determining means, responsive to receiving a request containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value, for determining whether the first hash value corresponds to a second hash value, wherein the second hash value represents a current policy configuration for processing requests by the data processing system; and

processing means, responsive to a correspondence between the first hash value and the second hash value, for processing the request using the information.

23. The data processing system method of claim 22, wherein the determining means is a first determining means and further comprising:

second determining means, responsive to receiving a request containing the selected cookie, for determining whether the selected cookie is stale;

generating means, responsive to an absence of a determination that the cookie being is stale, for generating a new classification for the request; and

preventing means, responsive to the cookie being stale, for preventing initiation of the determining means.

24. The data processing system of claim 23, wherein the processing means is a first processing means and further comprising:

second processing means, responsive to an absence of the selected cookie, for processing the request with the current policy configuration to generate a first classification for the request;

applying means for applying a hashing algorithm to the current policy configuration to generate the first hash value; and

placing means for placing the first hash value and information associated with the first hash value within a new cookie.

25. The data processing system of claim 22, wherein the selected cookie includes a universal resource identifier, a user identification, and a group identification.

26. The data processing system of claim 22, wherein the information includes a quality of service indicator.

27. A computer program product in a computer readable medium for processing a request, the computer program product comprising:

first instructions for receiving the request;

second instructions, responsive to a first hash value being present within the request, for comparing the first hash value to a second hash value, wherein the second hash value represents a current policy configuration for a quality of service; and

third instructions, responsive to a match between the first hash value and the second hash value, for setting a quality of service based on information associated with the first hash value.

28. The computer program product of claim 27, wherein the first hash value and the information are located in a cookie within the request.

29. The computer program product of claim 28, wherein the cookie is located within a header of the request.

30. The computer program product of claim 27, wherein the request is a hypertext transport protocol request.

31. The computer program product of claim 27 further comprising:

fourth instructions, responsive to an absence of a hash value in the request, for identifying a policy rule for processing the request to form an identified policy rule;

fifth instructions for identifying a classification for the request using the identified policy rule;

sixth instructions for hashing the current policy configuration, of which the identified policy rule is a part, using a hashing algorithm to generate a current hash value; and

seventh instructions for placing the current hash value and the information into the request.

32. The computer program product of claim 31, wherein the hash value and the information are placed in a cookie.

33. The computer program product of claim 27, wherein the data processing system is a server.

34. A computer program product in a computer readable medium for processing a request, the computer program product comprising:

first instructions, responsive to receiving a request containing a selected cookie in which the selected cookie includes a first hash value and information associated with the hash value, for determining whether the first hash value corresponds to a second hash value, wherein the second hash value represents a current policy configuration for processing requests by the data processing system; and

second instructions, responsive to a correspondence between the first hash value and the second hash value, for processing the request using the information.

35. The computer program product of claim 34 further comprising:

third instructions, responsive to receiving a request containing the selected cookie, for determining whether the selected cookie is stale;

fourth instructions, responsive to an absence by a determination that the cookie being is stale, for generating a new classification for the request; and

fifth instructions, responsive to the cookie being stale, for preventing initiation of the determining step.

36. The computer program product of claim 35 further comprising:

sixth instructions, responsive to an absence of the selected cookie, for processing the request with the current policy configuration to generate a first classification for the request;

seventh instructions for applying a hashing algorithm to the current policy configuration to generate the first hash value; and

eighth instructions for placing the first hash value and information associated with the first hash value within a new cookie.

37. The computer program product of claim 34, wherein the selected cookie includes a universal resource identifier, a user identification, and a group identification.

38. The computer program product of claim 34, wherein the information includes a quality of service indicator.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.